

REMARKS

Claims 1-6 and 15-19 are pending in this application. Claims 7-14 have been previously cancelled. Claims 1 and 6 have been previously amended. Claims 20 and 21 has been added. The application has been carefully reviewed in light of the Office Action mailed on March 13, 2008. Reconsideration of all outstanding rejections in view of the following remarks is respectfully requested.

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barnes (US Patent No. 5,970,475) in view of Howard (U.S. Patent No. 6,768,994) and further in view of Rosenfeld (U.S. Patent No. 6,901,377).

Barnes, Howard and Rosenfeld do not suggest or discloses each element of the combinations recited in claims 1-6. For example, amended claim 1 recites, *inter alia*, "a method for collecting, accessing, manipulating, and selectively displaying data, said method comprising the steps of ... collecting data relating to ... at least one federal appropriation related task funding code, repair cost" The Office Action on page 3 acknowledges that Barnes does not disclose, *inter alia*, "at least one federal appropriations related task funding code" and "repair cost", but contends that Rosenfeld at Col. 5, lines 38-40 discloses "task funding". In fact, the cited section of Rosenfeld actually discloses ONLY "initial cost estimates" rather than, *inter alia*, "at least one federal appropriation related task funding code" AND "repair cost". Even assuming Applicant accepts the Examiner's argument, only one but not both claim elements are disclosed thus claim 1 is clearly distinguished over Barnes and Rosenfeld. Online dictionary www.miriamwebster.com defines cost as, *inter alia*, "the amount or equivalent paid or charged for something" and defines funding as, *inter alia*, "to make provision of resources for discharging the interest or principal of b: to provide funds for <a federally funded program>". These two terms,

cost and funding, have two entirely different meanings thus cannot both be found in the referenced section of Rosenfeld which only speaks to "initial repair cost". The concept of funding is understood to have a separate meaning than cost given both terms are independent variables and constraints on decisions which are undertaken using the claimed invention. Further, Mirriamwebster.com defines appropriation as, *inter alia*, "an act or instance of appropriating; 2: something that has been appropriated; specifically: money set aside by formal action for a specific use." Nowhere in the cited section of Rosenfeld is any discussion of how initial cost estimate would teach or suggest a concept or action such as associated with "appropriation", much less "federal appropriation." In fact, an examination of Rosenfeld indicates that it is directed to commercial aviation manufacturers and repair activities rather than a system which includes data including, *inter alia*, both federal appropriation related task funding code data AND repair cost data, both of which have a separate and well understood meaning. Moreover, claim 1 recites the limitation "federal appropriations related task funding code ...". Mirriamwebster.com defines "code" as, *inter alia*, a system of signals or symbols for communication b: a system of symbols (as letters or numbers) used to represent assigned ... meanings ...". Again, the cited section of Rosenfeld only refers to "initial repair cost" rather than any "code", much less a "funding code", much less a federal appropriations related task funding code ...". Thus, the Office Action has not established a *prima facie* case of obviousness given the Office Action is clearly attempting to say these elements are present in Rosenfeld when it is in fact not present. Accordingly, claim 1 is allowable for the above reasons and for others.

The Office Action further states that it would have been obvious to incorporate the teachings of Rosenfeld and Howard into Barnes because it has historically been difficult for manufacturers to provide services for their clients citing Rosenfeld, Col. 1, lines 16-17. The Office Action further

contends the argued modification of Barnes, Howard and Rosenfeld is obvious due to "large companies [sometimes having] employees handling the ordering of parts or handling the repair and warranty process, and the overhead associated with not having a centralized database [costing] millions of dollars a year" citing Barnes Col. 1, lines 48-51. Applicant respectfully submits that the Office Action's proposed suggestion, teaching or motivation to combine does not provide an "apparent reason to combine the known elements in the fashion claimed by the patent in issue" and therefore lacks sufficient suggestive power to support a conclusion of obviousness.

As noted in the Office Action at page 2, the basis for all obviousness rejections is 35 U.S.C. § 103 which provides that "a patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person to a person having ordinary skill in the art to which said subject matter pertains." The Office Action further states that the factual inquiries set forth in Graham v. John Deer Co., 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a). In John Deer, the Supreme Court described four factors that are relevant to a determination of obviousness: (1) the scope and content of the prior art; (2) the skill level of a person of ordinary skill in the art; (3) the differences between the claimed invention and the prior art's teachings; and (4) any objective indications of obviousness or non-obviousness, such as the commercial success of the invention.

The Supreme Court recently further explained and clarified the John Deere decision in KSR International v. Teleflex Inc., U.S. Supreme Court No. 04-1350 (April 30, 2007). The KSR Court conceded that application of these principles may be difficult in

some cases "because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." (*KSR*, Slip Op. at 13-14.) The *KSR* Court explained that "[o]ften, it will be necessary for a court to ... determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." (*KSR* Slip Op. at 14.)

MPEP § 2143 sets forth the requirements to be shown by the Examiner in order to have successfully established a prima facie case of obviousness. As stated therein, to establish a case of prima facie obviousness: i) there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, ii) there must be a reasonable expectation of success, and iii) the prior art reference (or references when combined) must teach or suggest all the claim limitations. Moreover, MPEP § 2143.01 states that some additional objective reason to combine the teachings of references must be shown by the Examiner. That is, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01 quoting *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

No such teaching, suggestion or motivation is present in the cited references. Without using the present claims as a roadmap, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from the cited references. The rejections are based on an impermissible hindsight reconstruction of the present invention from the cited references that is not based on an "apparent reason to combine the known elements in the fashion claimed by the patent at issue." See *KSR* Slip Op. at 14; See also *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. App. 1985) (requiring "convincing line of

reasoning" to support obviousness determination). The fact that the present invention was made by the Applicant does not make the present invention obvious; that suggestion or teaching must come from the prior art. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998).

Even assuming for argument's sake that the Office Action is correct in stating all elements of the claims are present in Barnes, Howard and Rosenfeld, there is not an "apparent reason" to combine the references in the manner suggested by the Office Action. The suggestive power of the references must be weighed and used to determine whether there is an adequate or apparent suggestion or motivation to combine the references to reach a claimed combination. See KSR and MPEP 2143.01, Suggestion or Motivation to Modify the References. The reason offered by the Office Action refer to the most general and vague motivations of difficulty of providing services for clients, a statement that large companies have employees handling repair and warranty processes and costly overhead associated with a failure to have a centralized data base.

Mirriam-Webster's online dictionary defines the term "apparent" as "1: open to view : VISIBLE; 2: clear or manifest to the understanding <reasons that are readily apparent>; 3 : appearing as actual to the eye or mind; 4 : having an indefeasible right to succeed to a title or estate; 5 : manifest to the senses or mind as real or true" (See <http://www.mirriamwebster.com/dictionary/apparent>) In this case, the general reasons cited by the Office Action to not rise to the level of an "apparent", clear or manifest reason to combine the elements of claim 1. Moreover, common sense tells us that a vague general suggestion or motivation is not likely to motivate a person skilled in the art of an invention to search out specific references or to motivate them to combine multiple references in the manner suggested by the Office Action. The suggestive power of the Office Action's motivations to combine the three references

to reach the claimed invention is weak and tenuous at best therefore does not rise to the level of required evidence to meet either the threshold for obviousness or the "substantial evidence" standard of review under the Administrative Procedures Act (APA). As noted In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), the standard of review under the APA for a finding by the USPTO is "concrete evidence in the record in support of these findings." In fact, logic and basic mathematics regarding combinational and permutations tells us that the more references that are sought to be combined, the less of a probability that such a combination would in fact occur. As the degree of generality of the references increases, the probability that a person skilled in the art would in fact reach the claimed invention so decreases. Accordingly, the proposed generic motivations do not reach the level of "concrete evidence" with a sufficient nexus or suggestive power between the claimed combination and the Office Action's findings.

Accordingly, for the above and other reasons, claim 1 is allowable over Rosenfeld, Barnes and Howard.

Claims 2-5 depend from claim 1, thus are allowable for the above and other reasons.

In another example, claim 6 recites, *inter alia*, "a system for collecting, storing, querying, and maintaining data, said system comprising ... means for collecting data that characterizes ... at least one federal appropriation related funding code, repair cost," For the same reasons as noted above, none of the cited references disclose "funding" Accordingly, claim 6 is allowable over the cited references for at least the foregoing reasons.

Claims 15 through 19 depend from claim 6, directly or indirectly, thus are allowable along with claim 6 and for other reasons. For at least these reasons the Office Action fails to establish a *prima facie* case of obviousness and withdrawal of the

rejection of claims 1-6 and 15-19 is respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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Respectfully submitted,

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